

### **DETAILED ACTION**

Applicant's amendment and argument of 3/10/08 are entered.

Claim 13 is cancelled.

Claims 6-8 are amended.

Claims 1-12 are presently pending and considered.

### ***ABSTRACT***

It is noted that the abstract is now provided as a separate page, and is acceptable.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the Examiner cannot differentiate the particulars of the drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

It is noted that the drawings appear to be black-and-white line drawings (photocopies) of pictures. It is recommended that Applicant provide the actual pictures, along with any required petitions to accept color drawings or an explanation that no other form of drawing is possible but the pictures (if black and white), thereby complying with Office procedures.

### ***Response to Argument – color photographs***

Applicant's petition states that three paper copies of the color photographs of Figures 1 and 2 at a later time (Applicant's petition).

Such is not sufficient to comply with the requirements for color photographs. Applicant's petition is not accepted, and hence, the objection to the drawings remain.

### ***Claim Objections***

In light of the amendments to Claims 6 and 7, the previous objections of record are withdrawn. In addition, Claims 6 and 7 are now considered on the merits.

Claims 2 and 8-12 are objected to because of the following informalities:

Claim 2 recites "P" in the formula indicating the number of non-terminal inositol monomers of the inositol polymer. However, such technically lacks antecedent basis, as the parent claim, Claim 1, recites "p" as the same number. The Artisan would know what is being claimed, and hence, the claim is not rejected, but Applicant is required to correct the technical disagreement.

Claim 8 recites "comprising an inositol derivative of formula (I) and the drug or diagnostic agent: [formula provided]". Such technically does not make sense, but since the Artisan would know what is being claimed, the claim is not rejected for lack of clarity. It is recommended to amend the claim to recite "comprising a drug or diagnostic agent and an inositol derivative of formula (I): [formula I], wherein ....

Claims 9-12 are objected to for depending from an objected-to base claim.

Appropriate correction is required.

Art Unit: 1633

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The objection to Claim 8 is withdrawn under double-patenting, because Applicant has amended the claim to include the drug.

The Examiner thanks the Applicant for noting the proper claim in the response, and it is confirmed that the Examiner meant to object to Claim 6, as a warning. However, the point is moot, as Applicant has overcome the basis of the warning.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In light of Applicant's amendments, the previous rejections of record under this paragraph are withdrawn.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1633

Claim 6 recites the limitation "corresponding to R[1] group". There is insufficient antecedent basis for this limitation in the claim. Proper antecedent basis is "corresponding to R[1] groups".

Claim 6 recites the limitation "the amino acid R[1] N-terminus". There is insufficient antecedent basis for this limitation in the claim. Proper antecedent basis is "the amino acid R[1] N-termini".

Claim 7 is rejected for depending from a rejected base claim.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In light of the amendments, the rejections of Claims 1-12 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for delivering a drug or diagnostic agent across a cellular membrane into a cell, does not reasonably provide enablement for transport across the nuclear membrane into a nucleus, is withdrawn.

To wit, the amendments now simply require transport across a cellular membrane.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT M. KELLY whose telephone number is (571)272-0729. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1633

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